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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,822	11/29/2000	Olivier Guiter	PALM-3535.US.P	2236
49637 7590 03/21/2007 BERRY & ASSOCIATES P.C. 9255 SUNSET BOULEVARD SUITE 810 LOS ANGELES, CA 90069			EXAMINER CHEN, SHIN HON	
			ART UNIT 2131	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE			MAIL DATE	DELIVERY MODE
3 MONTHS			03/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/726,822

Applicant(s)

GUITER ET AL.

Examiner

Shin-Hon Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 6-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3 and 6-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1, 3, 6-28 have been examined.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/30/06 has been entered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 3, 6, 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Varadharajan et al. U.S. Pat. No. 5887063 (hereinafter Vara) and further in view of Kikinis et al. U.S. Pat. No. 5600800 (hereinafter Kikinis) and further in view of Fogle U.S. Pat. No. 6418534 (hereinafter Fogle).

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5. As per claims 1, Clark discloses a method for preventing unauthorized transfer of data between a portable computer system and systems of data storage and communication including an other computer (Clark: [0009]-[0011]), said method comprising the steps of:

automatically receiving identification authentication information for said portable computer system at a communication device embodied as a cradle for said portable computer system, wherein said authentication information comprises a unique identity for said portable computer system and wherein said authentication information is embedded in said portable computer system (Clark: [0009]-[0011] and [0060]: serial number);

comparing said identification authentication information with a list of authorized portable computer system identities (Clark: [0060]);

determining whether said portable computer system identity is authorized based on said identification authentication information and said unique identity (Clark: [0060]);

enabling communication and synchronization between said portable computer system and said other computer provided said identity is authorized and disabling said communication if said identity is not authorized (Clark: [0060]);

Clark does not explicitly disclose e.) enabling decryption of encrypted data from said portable computer system provided said identity is authorized and disabling decryption if said identity is not authorized. However, Vara discloses enabling the portable computer to communicate with host by establishing secure key for secure communication after authentication has been completed (Vara: column 4 line 54 – column 5 line 31). It would have been obvious to one having ordinary skill in the art to enable/disable encryption based on authentication because it is well known in the art to have secure communication between two devices. Therefore, it

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would have been obvious to one having ordinary skill in the art to combine the teachings of Vara within the system of Clark because it increases system security by communicating encrypted data/information after authentication has been completed to provide additional security.

Clark as modified further discloses wherein step a) comprises the step of transferring identification authentication information between a portable computer system portable device and a communication interface device (Clark: figures 1a-c and [0009]-[0011] and [0060]) and said portable device is a palmtop computer and said interface device is a palmtop computer system cradle (Clark: [0009]-[0011]). Clark as modified does not explicitly disclose transferring authentication from communication interface device to portable computer. However, Kikinis discloses that limitation (Kikinis: column 10 line 50 – column 11 line 24). It would have been obvious to allow bi-directional authentication to authenticate the device that seeks to retrieve information from the other device. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Kikinis within the combination of Clark-Vara because it's well known in the art to authenticate requesting device prior to access.

Clark as modified does not explicitly disclose the steps of comparing, determining, enabling is done at said communication interface device. However, Fogle discloses a portable computer is authenticated at a docking station (Fogle: column 1 line 55 – column 2 line 26). It would have been obvious to one having ordinary skill in the art to authenticate portable computer system at docking station/cradle because cradle is a communication medium between portable computer system and host computer and the use of firewall between two networks can be easily applied to the art. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Fogle within the combination of

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Clark-Vara-Kikinis because it prevents unauthorized users from directly accessing protected information.

6. As per claim 3, Clark as modified discloses the method as recited in Claim 1. Clark as modified further discloses wherein said identification authentication information is transferred from said portable computer system to said interface device to uniquely identify said portable computer system to said interface device (Clark: [0060]).

7. As per claim 6, Clark as modified discloses the method as recited in Claim 1. Clark as modified further discloses wherein said step b) comprises the steps of: recognizing said identification authentication information as an indication of unique identity of the source sending said information (Clark: [0060]) and indexing said unique identity to a list of programmed identities (Clark: [0060]). Kikinis also discloses these limitations (Kikinis: column 11 lines 8-15). Same rationale applies here as above in rejecting claim 2.

8. As per claim 8, Clark as modified discloses the method as recited in Claim 1. Clark as modified further discloses wherein said step d) comprises the steps of allowing said portable computer to synchronize with said other computer upon authorization of communication and preventing synchronization upon prohibition of communication (Clark: [0060]).

9. As per claim 9, Clark as modified discloses the method as recited in Claim 1. Clark as modified further discloses wherein step e) comprises the steps of disclosing a specific key value

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with which said data is encrypted upon authorization of communication and not disclosing said specific key value upon prohibition of communication (Vara: column 4 line 54 – column 5 line 31).

10. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Vara and further in view of Kikinis and further in view of Fogle and further in view of Frederick U.S. Pat. No. 6157825 (hereinafter Frederick).

11. As per claim 7, Clark as modified discloses the method as recited in Claim 1. Clark as modified further discloses wherein said step c) comprises the steps of: reacting to positive indexing match as an authenticated authorized identity (Clark: [0060]); and authorizing communications enablement in response to an authenticated authorized identity, and prohibiting communications in response to an unauthorized identity (Clark: [0060]). Clark does not explicitly disclose reacting to negative indexing match as an unauthorized identity. However, Frederick discloses checking both authorized list and unauthorized list for authentication (Frederick: column 5 line 60 – column 6 line 35). It is well known in the art to check authorized users and unauthorized users. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Frederick within the combination of Clark-Vara because checking authorized and unauthorized offers other options for users who are neither authorized nor unauthorized users.

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12. Claims 10-13 and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Vara.

13. As per claim 10, Clark discloses a system for preventing unauthorized transfer of data between a portable computer system and a host system (Clark: [0009]-[0011] and [0060]), comprising:

14. a portable computer device capable of synchronizing with said host (Clark: figures 1a-c and [0009]-[0011]);

15. an interface device compatible to receive said portable computer device and capable of facilitating communication between said portable computer device and said host system (Clark: figures 1a-c and [0009]-[0011]);

16. an identification authenticating component embedded into one of said devices and providing a unique identification signal corresponding to the unique identity thereof (Clark: [0009]-[0011] and [0060]: serial number); and

17. d.) an identification authorizing component capable of determining if said unique identity is authorized for synchronization and for correspondingly enabling and disabling synchronization between said portable computer and said host system (Clark: [0060]).

18. Clark does not explicitly disclose e.) enabling decryption of encrypted data from said portable computer system provided said identity is authorized and disabling decryption if said identity is not authorized. However, Vara discloses enabling the portable computer to communicate with host by establishing secure key for secure communication after authentication has been completed (Vara: column 4 line 54 – column 5 line 31). It would have been obvious to

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one having ordinary skill in the art to enable/disable encryption based on authentication because it is well known in the art to have secure communication between two devices. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Vara within the system of Clark because it increases system security by communicating encrypted data/information after authentication has been completed to provide additional security.

19. As per claim 11 and 12, Clark as modified discloses a system as in Claim 10. Clark further discloses wherein said portable computer device is a palmtop computer and said interface device is a palmtop computer cradle (Clark: [0009]-[0011]).

20. As per claim 13, Clark as modified discloses a system as in Claim 10. Clark does not explicitly disclose wherein said synchronous communication is further encrypted with a specific key value from said identification authenticating tagging component such that unauthorized applications external to said portable computer system are locked out from deciphering data therefrom. However, Vara discloses that limitation (Vara: column 4 line 54 – column 5 line 31). It would have been obvious to one having ordinary skill in the art to combine the teachings of Vara within the system of Clark because it increases system security by communicating encrypted data/information after authentication has been completed to provide additional security.

21. As per claim 17, Clark as modified discloses a system as in Claim 10. Clark as modified further discloses wherein said identification authorizing component is a software program

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(Clark: [0060]). Computers require the combination of software and hardware to accomplish authentication tasks.

22. As per claim 18, Clark as modified discloses a system as in Claim 10. Clark as modified further discloses wherein said identification authenticating tagging component is in direct electrical connection with said identification authentication reading component via contacts (Clark: [0009]-[0011] and figures 1a-c).

23. As per claim 19, Clark as modified discloses a system as in Claim 10. Clark as modified does not explicitly disclose wherein said identification authenticating tagging component is in contact free communication with said identification authentication reading component via an infrared communication mechanism. However, Vara discloses that limitation (Vara: column 4 lines 22-34). It would have been obvious to one having ordinary skill in the art to combine the teachings of Vara within the system of Clark because it is well known in the art to use various types of product for transmitting signals between two devices.

24. As per claim 20, Clark as modified discloses a system as in Claim 9. Clark as modified further discloses wherein said identification authenticating tagging component is in contact free communication with said identification authentication reading component via a transmitter/receiver modality and antenna array (Vara: column 4 lines 22-34).

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25. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Vara and further in view of Pickholtz U.S. Pat. No. 4593353 (hereinafter Pickholtz).

26. As per claim 14, Clark as modified discloses a system as in Claim 10. Clark as modified does not explicitly disclose wherein said identification authenticating tagging component is a magnetic key and said identification authentication reading component is a magnetic key reader. However, Pickholtz discloses using magnetic key to achieve identification and authentication (Pickholtz: column 1 lines 39-45). It would have been obvious to one having ordinary skill in the art to combine the teachings of Pickholtz within the system of Clark because identification authentication can apply to various types of products including magnetic keys.

27. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Vara and further in view of Graves U.S. Pat. No. 5239166 (hereinafter Graves).

28. As per claim 15, Clark as modified discloses a system as in Claim 10. Clark as modified does not explicitly disclose wherein said identification authenticating tagging component is a smart card and said identification authentication reading component is a smart card reader. However Graves discloses that limitation (Graves: column 2 line 29 – column 3 line 32). It would have been obvious to one having ordinary skill in the art to combine the teachings of Graves within the system of Clark because identification authentication can apply to various types of products including smart card, which is well known in the art.

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29. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Vara and further in view of Kelly et al. U.S. Pat. No. 6480101 (hereinafter Kelly).

30. As per claim 16, Clark as modified discloses a system as in Claim 10. Clark as modified does not explicitly disclose wherein said identification authorizing component is an application specific integrated circuit. However, Kelly discloses that limitation (Kelly: abstract and column 2 line 30-55 and column 3 lines 32-57). It is well known in the art that ASIC is very difficult to tamper with and good for conducting authentication purposes. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Kelly within the system of Clark.

31. Claims 21, 22, and 27 rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Vara and further in view of Kikinis.

32. As per claim 21, Clark discloses a system for preventing unauthorized transfer of data between a portable computer system and a system of data storage and communication, comprising:

a portable computer device capable of synchronizing with said system of data storage and communication (Clark: [0009]-[0011] and figures 1a-c);

an interface device compatible to receive said portable computer device and coupled with said system of data storage and communication and capable of facilitating communication

between said portable computer device and said system of data storage and communication (Clark: [0009]-[0011] and figures 1a-c);

d.) an identification authentication reading component capable of sensing and reading said unique identification signal embedded into the other of said devices not incorporating said tagging component (Clark: [0060]: serial number);

e.) an identification authorizing component receiving input from said reading component and incorporated into the same one of said devices as said reading component, capable of determining if said unique identity is authorized for synchronization and of correspondingly enabling and disabling synchronization between said portable computer and said system of data storage and communication (Clark: [0060]).

Clark does not explicitly disclose c) an identification authenticating-tagging and data encryption keying component incorporated into one of said devices and providing a unique identification signal and an encryption key cipher value corresponding to the unique identity thereof; and

f.) an identification authorizing component further capable of enabling deciphering of encrypted communication from said portable computer device if said unique identity is authorized and disabling decryption if said unique, identity is unauthorized.

However, Vara discloses the portable device returns data for authentication regarding keys (Vara: column 5 lines 32 – 55) and authenticate if the received value is valid and establish secure key for communication if authentication is successful (Vara: column 4 line 54 – column 5 line 31). It would have been obvious to combine the teachings of Vara within the system of Clark

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because it increases security by authenticate using key algorithms in addition to identification authentication.

Clark as modified discloses a host computer authenticates portable computer but not vice versa. However, Kikinis discloses a portable computer authenticates a host computer when the host computer tries to access data stored within the portable computer (Kikinis: column 10 line 50 – column 11 line 24). It would have been obvious to allow bi-directional authentication to authenticate the device that seeks to retrieve information from the other device. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Kikinis within the combination of Clark-Vara because it is well known in the art to authenticate requesting device prior to access.

33. As per claim 22, Clark as modified discloses a system as in Claim 20. Clark as modified further discloses wherein said identification authorizing component incorporates software for determining if said unique identity is authorized for synchronization, for correspondingly enabling and disabling synchronization, and deciphering encrypted data from said portable computer device (Vara: column 4 lines 54 – column 5 line 31).

34. As per claim 27, Clark as modified discloses a system as recited in claim 21. Clark as modified further discloses wherein said interface device is a palmtop computer cradle (Clark: [0009]-[0011] and [0060]).

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35. Claims 23, 25, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Kikinis.

36. As per claim 23, Clark discloses a communication system comprising: a host computer system comprising a communication port (Clark: figures 1a-c and [0009]-[0011]); a portable electronic device comprising a communication port and an identity reference, said identity reference embedded into said portable computing device (Clark: figures 1a-c and [0009]-[0011] and [0060]: serial number); and a communication interface module separate from said host computer system for coupling and synchronization between said communication ports of said portable electronic device and said host computer system (Clark: figures 1a-c and [0009]-[0011] and [0060]), and disallowing communication between said portable electronic device and said host computer system if authentication failed (Clark: [0060]).

37. Clark does not explicitly disclose said communication interface module comprising: an authentication device for authenticating said identity reference; and a communication interface circuit coupled to said authentication device and for allowing communication between said portable electronic device and said host computer system provided said authentication device indicates a proper authentication of said identity reference. However, Kikinis discloses these limitations (Kikinis: figure 41 and column 10 line 50 – column 11 line 15). It would have been obvious to one having ordinary skill in the art to combine the teachings of Kikinis within the system of Clark because it reduces data transmission between devices.

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38. As per claim 25, Clark as modified discloses a communication system as described in Claim 23. Clark as modified further discloses wherein said communication module contains a slot for receiving said communication port of said electronic device (Kikinis: figures 5, 6, and 41).

39. As per claim 28, Clark as modified discloses a communication system in claim 23. Clark further discloses wherein said communication module is a palmtop computer cradle (Clark: [0009]-[0011] and [0060]).

40. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Kikinis and further in view of Vara.

41. As per claim 24, Clark as modified discloses a communication system as described in Claim 23. Clark as modified does not explicitly disclose wherein said communication interface circuit comprises a decryption circuit. However, Vara discloses that limitation (Vara: column 4 lines 35-43 and figure 1). It would have been obvious to include the decryption circuit in the communication interface, which is coupled to the host computer to decrypt encrypted data communication from the host computer and portable computer. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Vara within the combination of Clark-Kikinis because allow secure communication between the portable computer and host computer.

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42. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Clark in view of Kikinis and further in view of Kramer U.S. Pat. No. 6286099 (hereinafter Kramer).

43. As per claim 26, Clark as modified discloses a communication system as described in Claim 23. Clark as modified does not explicitly disclose wherein said identity reference is stored on a removable smart card. However, Kramer discloses that limitation (Kramer: column 4 lines 18-25). It is well known in the art to use smart card to enable devices to receive data/services. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Kramer within the combination of Clark-Kikinis.

Response to Arguments

44. Applicant's arguments 7/31/06 have been fully considered but they are not persuasive.

Regarding applicant's remarks, applicant argues that the prior art of record does not disclose having a serial number embedded in a portable computer for synchronization. However, Clark clearly discloses that the serial number is transmitted to host prior to synchronization (Clark: [0060]). Furthermore, In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shin-Hon Chen
Examiner
Art Unit 2131

SC

CHRISTOPHER REVAK
PRIMARY EXAMINER
